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REMARKS

Claim rejections under 35 USC 103 as to Budge in view of Bates

Claims 1-2, 8-14, and 19-20 have been rejected under 35 USC 103(a) as being unpatentable over Budge (6,564,248) in view of Bates (6,721,781). Claims 1, 12, and 19 are independent claims, from which claims 2, 8-11, 13-14, and 20 depend. Applicant submits that claims 1, 12, and 19 are patentable over Budge in view of Bates, such that claims 2, 8-11, 13-14, and 20 are patentable for at least the same reasons.

Applicant specifically discusses claim 12 as representative of claims 1, 12, and 19 insofar as patentability over Budge in view of Bates is concerned. Claim 12 is limited to "an audio or video program encompassing the one or more audio or video controls [being] *integrated with* the predetermined application program," where "the audio or video program [is] *separate from* the predetermined application program." That is, claim 12 has two specific limitations that are discussed herein: (1) the audio or video program encompassing the audio or video controls is "integrated with" the predetermined application program, but (2) the audio or video program is also "separate from" the predetermined application program.

Furthermore, claim 12 has been amended so that it is clear that the "audio or video program" is the program that "present[s] one or more audio or video controls for use in conjunction with the predetermined application program." That is, claim 12 is limited to both an audio or video program and a predetermined application program, where it is the audio or video program that specifically presents the audio or video controls for use in conjunction with the predetermined application program.

Applicant contends that all these limitations are not found in Budge in view of Bates, or that Budge in view of Bates does not render these limitations obvious, for the following reasons. First, Budge does not disclose the limitations of the claimed invention as indicated by the Examiner, such that the claimed invention is not obvious over Budge in view of Bates. Second,

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Bates does not disclose the limitations of the claimed invention as indicated by the Examiner, such that the claimed invention is not obvious over Budge in view of Bates. Third, Bates is not properly combined with Budge, such that the claimed invention is not obvious over Budge in view of Bates. Each of these reasons is now discussed in detail.

Budge does not disclose certain limitations of the invention as indicated by the Examiner

The Examiner relies upon Budge as teaching the detection of an event related to a predetermined application program, and an audio or video program presenting audio or video controls in conjunction with the predetermined application program. Because the Examiner specifically relies upon Budge in teaching this aspect of the claimed invention, Applicant discusses Budge in particular to show why Budge in view of Bates does not disclose this aspect of the claimed invention. That is, Applicant is very much cognizant that the instant rejection was proffered under 35 USC 103(a) over Budge in view of Bates; Applicant discusses Budge alone in this section of the office action response because the Examiner relied upon Budge alone in teaching certain aspects of the claimed invention, and Applicant disagrees with the Examiner's interpretation of Budge.

The Examiner specifically indicates in paragraph 5.a.i. on page 3 of the Office Action that the predetermined application program of Budge is the "video e-mail software 50." However, the claimed invention as amended is limited to "detecting when an event related to a predetermined application program occurs," and in response, "an audio or video program presenting one or more audio or video controls for use in conjunction with the predetermined application program." That is, the claimed invention is limited to a predetermined application program, and an audio or video program that is *separate from* the predetermined application program, where the audio or video program is the program that presents the audio or video controls.

Therefore, if the video e-mail software 50 is the claimed invention's predetermined application program in Budge, then there has to be a *different* program in Budge – the claimed

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invention's audio or video program – that presents the audio or video controls for use in conjunction with the predetermined application program. This is because the claimed invention's predetermined application program is *separate from* the audio or video program. However, Budge does not disclose a program *separate from* the predetermined application program (i.e., the video e-mail software 50) presenting the audio or video controls. Rather, the controls of FIG. 6 in Budge that the Examiner equates to the audio or video controls of the claimed invention are actually provided by the video e-mail software 50 – i.e., the program that the Examiner has already equated to the predetermined application program of the claimed invention.

For instance, "FIG. 6 illustrates a portion of the GUI for the preferred embodiment of the video e-mail recorder." (Col. 5, ll. 59-60) The video e-mail recorder is a part of the video e-mail software 50 in Budge:

FIG. 2 illustrates the preferred embodiment of the invention in which the video e-mail software . . . resides . . . The main software components of the video e-mail system are the video e-mail recorder 210 and the video e-mail player 220.

(Col. 4, ll. 30-36) Therefore, Budge does not disclose the elements of the claimed invention as interpreted by the Examiner, such that Budge in view of Bates does not render the claimed invention obvious.

That is, the Examiner has equated the video e-mail software 50 of Budge to the claimed invention's predetermined application program. However, under this interpretation, Budge would have to have a *separate* program – the claimed invention's audio or video program – as presenting audio or video controls in conjunction with the predetermined application program (i.e., the video e-mail software 50). But in Budge, a video-email recorder component of the same video e-mail software 50 (i.e., the predetermined application program) presents the audio or video controls. Thus, whereas in the claimed invention there is a predetermined application program and an audio or video program, where it is the latter presents audio or video controls, in Budge, if the video e-mail software 50 is the predetermined application program, then it is the program that

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presents the audio or video controls – not a separate audio or video program as in the claimed invention.

Stated another way, say that the predetermined application program of the claimed invention is program A, the audio or video program is program B, and the audio or video controls are controls C. The claimed invention is limited to program A being separate from program B, and program B presenting the controls C. Now, the Examiner states that Budge's video-email software 50 is the predetermined application program A. However, Budge teaches that the video-email software 50 presents the audio or video controls C. Therefore, whereas the claimed invention is limited to two programs A and B, where program B presents controls C, Budge teaches program A presenting the controls C, using the Examiner's interpretation of Budge. As a result, there is no way that Budge discloses this aspect of the claimed invention as limited by the claims, such that Budge in view of Bates does not render the claimed invention unpatentable.

Bates does not disclose certain limitations of the invention as indicated by the Examiner

Second, the Examiner indicates that

Budge does teach the predetermined application program and the audio or video program. Budge, however, does not explicitly teach the programs separate but integrate[d]. Bates teaches the program[s] separate but integrate[d].

(Office Action, p. 3, paras. b-c) Because the Examiner relies specifically upon Bates in teaching separate but integrated programs, Applicant discusses Bates in particular to show why Budge in view of Bates does not disclose an audio or video program being integrated with but separate from a predetermined application program, as in the claimed invention. That is, as stated above in relation to Budge, Applicant is very much cognizant that the instant rejection was proffered under 35 USC 103(a) over Budge in view of Bates; Applicant discusses Bates alone in this section of the office action response because the Examiner relied upon Bates alone in teaching certain

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aspects of the claimed invention, and Applicant disagrees with the Examiner's interpretation of Bates.

The Examiner specifically relies upon FIG. 3 of Bates and its associated text as disclosing a program that is separate from but integrated with another program. The relevant portion of the discussion of FIG. 3 in Bates reads as follows.

Browser 322 may be integrated into operating system 321, OR may be a separate application program.

(Col. 7, ll. 6-8) As an initial matter, Bates teaches two different embodiments. First, the browser 322 may be integrated into the operating system 321. Second, the browser may be a separate application program, separate from the operating system 321.

By comparison, the claimed invention is limited to the "audio or video program . . . integrated with the predetermined application program, [and] the audio or video program being separate from the predetermined application program." That is, the claimed invention is limited to the audio or video program being *BOTH* integrated with the predetermined application program *AND* separate from the predetermined application program. Bates, however, does not teach this limitation of the claimed invention. Rather, Bates teaches that *EITHER* the browser 322 may be integrated into the operating system 321, *OR* the browser 322 may be an application program separate from the operating system 321. Therefore, there is no way Bates teaches this aspect of the claimed invention, such that Budge in view of Bates does not render the claimed invention unpatentable.

In sum, whereas Bates discloses that the browser 322 may be integrated into the operating system 321 *OR* that the browser 322 may be a separate application program, the claimed invention is limited to the audio or video program being *BOTH* integrated with the predetermined application program *AND* separate from the predetermined application program. Stated another way, Bates teaches A *OR* B, whereas the claimed invention is limited to A *AND* B. Therefore,

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Bates does not teach this aspect of the claimed invention, and Budge in view of Bates does not render the claimed invention unpatentable.

Furthermore, the Examiner committed another misinterpretation of Bates in rejecting the claimed invention over Budge in view of Bates. The claimed invention is limited to a predetermined application program and an audio or video program, where the latter program is separate from but integrated with the former program. However, as can be appreciated by those of ordinary skill within the art, an audio or video program is another application program. Thus, the claimed invention is limited to two application programs that are separate from but integrated with one another: a first application program referred to as a predetermined application program, and a second application program referred to as an audio or video program.

However, Bates discloses its integration *OR* separation as to an application program, the browser 322, and the operating system 321, which is *not* an application program. Therefore, Bates also cannot disclose the claimed invention's integration *AND* separation of two application programs, because it does not disclose two application programs. Rather, Bates discloses one application program, the browser 322, and a non-application program, the operating system 321. One of ordinary skill within the art can readily appreciate that an operating system is most definitely not an application program. Therefore, Bates further does not teach this aspect of the claimed invention, because it discloses two different types of computer programs – an application program and an operating system – whereas the claimed invention is limited to two application programs. For this reason, too, Budge in view of Bates does not render the claimed invention unpatentable.

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Budge is not properly combined with Bates

The Examiner's stated reason for combining Budge with Bates is as follows.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Bates and Budge because Bates's teaching would have provided the capability for accommodating the combination of the two programs within a single computing device, and therefore, prov[id]ing compatibility for Budge's system.

(Office Action, p. 4, para. d) This stated reason for combining Budge with Bates, however, does not make sense on a number of different levels, such that in actuality there is no reason within the prior art to combine Budge with Bates.

First, the Examiner states that "Bates's teaching would have provided the capability for accommodating the combination of the two programs within a single computing device." However, Budge *already discloses* using the combination of two programs within a single computing device, such as the single computing device 2 or 4 of FIG. 1 thereof. That is, Budge already teaches using the combination of a predetermined application program and an audio or video program within a single computing device. There is no reason to combine Bates with Budge to achieve this functionality, because Budge already provides this functionality itself. For this reason alone, there is no motivation within the prior art to combine Bates with Budge, such that combining Budge with Bates is improper.

Second, the Examiner states that compatibility for Budge's system would be provided by combining Budge with Bates. This statement is incorrect, because Budge is completely compatible in and of itself. The predetermined application program and the audio or video program of Budge are taught and disclosed within Budge as running on the computing device, or system, 2 or 4 of FIG. 1. No extra "compatibility" is needed or gained by combining Budge with Bates. Because Budge is completely compatible by itself, in that the predetermined application program and the audio or video program of Budge already can run in combination on the system of Budge without any problems, there is no reason to combine Bates with Budge to achieve this

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functionality. For this reason, too, there is no motivation within the prior art to combine Bates with Budge, such that combining Budge with Bates is improper.

In sum, Applicant notes the MPEP instructs that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the *desirability* of the combination.” (MPEP sec. 2143.01) In the present situation, Bates may very well *be able to be* combined with Budge. However, there is no *reason* within the prior art why such a combination is *desirable*. First, Bates does not provide Budge with the capability for accommodating the combination of the two programs within a single computing device, since Budge already has this capability. Indeed, the Examiner does not state why providing Budge with the capability for accommodating the combination of the two programs within a single computing device is even desirable, as required by the MPEP. Just because Bates *could* provide Budge with such capability does not mean that Budge *should* be “provided” with such capability, especially where Budge already *has* this capability. Second, and similarly, Bates does not provide Budge with “compatibility” for Budge’s system, since Budge already has such compatibility. There is no reason why it is desirable to combine Bates with Budge, such that combining Budge with Bates is improper.

Claim rejections under 35 USC 103 as to Budge in view of Bates and further in view of Poreh

Claims 3-7 and 15-18 have been rejected under 35 USC 103(a) as being unpatentable over Budge in view of Bates, and further in view of Poreh (5,889,518). However, claims 3-7 and 15-18 are dependent claims, depending from the independent claims discussed above in relation to the claim rejections as to Budge in view of Bates. Therefore, claims 3-17 and 15-18 are patentable for at least the same reasons that their base independent claims are patentable.

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Conclusion

Applicant has made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Michael Dryja, Applicant's Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited. Applicant strongly contends that the Examiner's rejection of the claimed invention would not be sustained on appeal.

Respectfully Submitted,



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Date

Michael Dryja, Reg. No. 39,662
Attorney/Agent for Applicant(s)

Michael Dryja, Esq.
Law Offices of Michael Dryja
704 228th Ave NE #694
Sammamish, WA 98074

tel: 425-427-5094
fax: 425-563-2098